

### REMARKS

This application has been carefully reviewed in light of the Office Action dated January 26, 2005. Claim 20 is in the application. Reconsideration and further examination are respectfully requested.

The specification was objected to because of an informality. The specification has been amended to correct the informality. Withdrawal of the objection is respectfully requested.

The drawings were objected to for allegedly failing to show every feature of the invention specified in the claim. Specifically, the Office Action contends that Figures 10 and 11 do not show an imaging element that comprises a first planarization layer covering the external terminal and a second planarization layer on the first planarization layer. Applicants traverse the objection to the drawings and respectfully submit that Figure 5 is the proper focus of the drawing inquiry. FIG. 5 shows an external terminal 120 covered by an adhesive material 105, which is planarized by using a light transmitting substrate 106 to form a planarizing layer. (paragraph 0056 of the Specification).

Claim 20 was rejected under 35 U.S.C. § 112, first paragraph. Specifically, the Office Action asserts that a step of forming a step in the first planarization layer is critical to the invention. The Office Action cites paragraphs 0009 to 0013 of the Specification in support of its position that the object of the invention is to form a space in the planarization layer to accommodate the external terminal. Applicants respectfully traverse the rejection because (1) the Specification expressly discloses such a space is only

a preferred aspect of one embodiment of the invention, and (2) the Specification clearly does not disclose that forming a space in the planarization layer is critical for the invention to function as intended.

MPEP § 2164.08(c) explains that, “[f]eatures which are merely preferred are not to be considered critical. *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976).” In this regard, the Specification expressly discloses, “each of the external terminals 120 is **preferably** formed on the side portion opposite to the incidence side of the light receiving surface . . . .” (Specification paragraph 0051, emphasis added). This preferred feature of the invention results from the inclusion of a step S, which Applicants presume is the allegedly critical feature recited in the Office Action as the “space in the planarization layer to accommodate the external terminal.” Step S is used to position the external terminals lower than the light receiving surface on the side portion opposite to the incidence side; however, as stated in paragraph 0051, this positioning is merely preferred. Accordingly, the feature of forming step S is not a critical feature.

Furthermore, MPEP § 2164.08(c) states, “[b]road language in the disclosure . . . omitting an allegedly critical feature, tends to rebut the argument of criticality.” The Office Action asserts that paragraphs 0009 through 0013 disclose that the object of the invention is to form a space in the planarization layer. On the contrary, the only objective disclosed in these paragraphs makes no mention of a space in a planarization layer. (paragraph 0011). Specifically, paragraph 0011 discloses an object of the present invention is to provide a radiation imaging apparatus permitting a planarizing layer to be formed by coating or bonding an adhesive, an organic resin, an adhesive sheet, or the like on a

plurality of spaced apart imaging elements. This statement of an objective omits the allegedly critical feature, and this makes sense because the allegedly critical feature is merely preferred. For this additional reason, Applicants submit that forming a space in the planarization layer is not a critical step. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Claim 20 was rejected under 35 U.S.C. § 112, second paragraph.

Specifically, the Office Action asserts that Claim 20 omits steps essential to the invention, such as forming a first planarization layer, forming a step in the planarization layer, disposing an external terminal, and extending a lead. Applicants respectfully traverse the rejection because 35 U.S.C. § 112 is explicit when it assigns to the Applicant the sole responsibility of defining what he regards as the invention:

“The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” 35

U.S.C. § 112 (emphasis added).

MPEP § 2172 explains that, “the invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention. *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971).” Claim 20 includes the features of the invention that Applicants regard as their invention, and the Specification discloses nothing to the contrary. For example, paragraph 0011 of the Specification states an object of the present invention is to provide a radiation imaging apparatus permitting a planarizing layer to be formed by coating or bonding an adhesive, an

organic resin, an adhesive sheet, or the like on a plurality of spaced apart imaging elements. This objective, like Claim 20, contains no mention of an external terminal or a lead from the external terminal, much less disposing an external terminal on a side of the step opposite to a light receiving surface or extending a lead connected to the external surface to the side opposite to the light receiving surface. Similarly, and as discussed above, neither this objective nor Claim 20 contains any mention of forming a space in a planarization layer.

Hence, Claim 20 does not omit any essential steps. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Claim 20 was rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,800,857 (Kajiwara). Applicants respectfully traverse the rejection. In addition, Applicants submit that Kajiwara is not prior art to the present application. Specifically, the present application claims benefit of the April 27, 2001 filing date of Japanese Application No. 2001-132349 (hereinafter “Japan ‘349”). It is Applicants’ current intention to submit a sworn translation of Japan ‘349, to remove Kajiwara as a reference. In the meantime, Applicants direct attention to FIG. 5 of Japan ‘349, which is already on file and which clearly shows support for the claimed subject matter, without need for translation. Applicants respectfully request that the Examiner remove Kajiwara as a reference.

Claim 20 was also rejected under obviousness-type double patenting over U.S. Patent No. 6,671,347 (Tashiro). Specifically, the Office Action asserts that the method steps of Claim 20 are obvious in view of claim 10 of Tashiro (“claim 10”). Applicants respectfully traverse the rejection for at least the reason that claim 10 recites “a

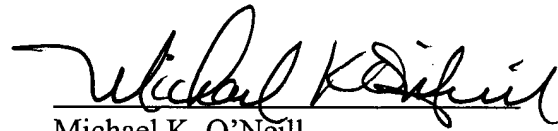
second planarization layer formed on the external terminal and the first planarization layer” and Claim 20 recites “forming a first planarization layer, which covers said external terminal.”

Applicants submit that Claim 20, which includes formation of a first planarization layer which covers the external terminal, is non-obvious from claim 10's second planarization layer formed on the external terminal and on the first planarization layer for the simple reason that the claims recite different layers covering the external terminal. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

No other matters being raised, it is believed that the entire application is fully in condition for allowance, and such action is courteously solicited.

Applicants' undersigned attorney may be reached in our Costa Mesa,  
California office at (714) 540-8700. All correspondence should continue to be directed to  
our below-listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael K. O'Neill", written over a horizontal line.

Michael K. O'Neill  
Attorney for Applicants  
Registration No. 32,622

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-2200  
Facsimile: (212) 218-2200

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